

Attorney Docket No.: ISPH-0569
Inventors: Anderson et al.
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REMARKS

Claims 1-24 are pending in this application. The pending claims have been subjected to a Restriction Requirement as follows:

Group I, claims 1-8 drawn to compounds 8 to 80 nucleobases in length targeting a nucleic acid molecule encoding beta-site APP cleaving-enzyme 2, classified in class 536, subclass 24.5.

Group II, claims 9-14, 19-20 drawn to method of treating HCV infection, classified in class 514, subclass 44.

Group III, claims 15-18, 21-22, drawn to a method of preventing HCV infection, classified in class 514, subclass 44.

Group IV, claims 23-24, drawn to an oligonucleotide composition comprising an oligonucleotide in a form suitable for subcutaneous administration and a method of inhibiting gene expression comprising administration and a method of inhibiting gene expression comprising administering said oligonucleotide.

The Examiner suggests that the Groups as set forth above are distinct each from the other because they are related as product and process of use. It is suggested that Groups I and III are related as product and process of use. The Examiner has suggested that the oligonucleotide of Group I can be used in a method of treating patients suffering from HCV infection. The Examiner has further suggested I and IV are unrelated. The Examiner has further

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suggested that a search of one group would not be co-extensive with a search of the other and would be burdensome. It is further suggested that they have acquired a separate status in the art, and that they should be restricted for examination purposes. Applicants respectfully disagree.

For a proper restriction requirement the MPEP §803 requires showing: (1) that the inventions are independent or distinct AND (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

All of claims of the instant application relate to the single concept of treatment of Hepatitis C virus-associated disease. Accordingly, each of the claims contain the components for use in the same endpoint, namely Hepatitis C treatment. Thus, Applicants respectfully disagree that the Groups set forth by the Examiner are distinct as being novel and unobvious over each other, as required by MPEP § 802.01.

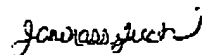
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Further, an art search relating to treatment of Hepatitis C virus-associated disease would identify art related to all of the claims of this application, and would not be overly burdensome to the Examiner.

Accordingly, the instant Restriction Requirement meets neither of the criteria as set forth by MPEP §803 to be proper. Reconsideration and withdrawal of this Restriction Requirement is therefore respectfully requested.

However, in an earnest effort to be completely responsive, Applicants hereby elect to prosecute Group IV, claims 23-24 with traverse.

Respectfully submitted,



Jane Massey Licata

Registration No. 32,257

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Licata & Tyrrell P.C.
66 Main Street
Marlton, NJ 08053

856-810-1515